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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,250	08/09/2001	Robert Elghanian	10907/15	5647

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EXAMINER

WHISENANT, ETHAN C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 11/20/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/928,250

Applicant(s)

ELGHANIAN ET AL.

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001 and 22 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. The applicant's Preliminary Amendment has been entered. The applicant's Preliminary Amendment filed on 10 OCT 01 and has been entered as paper no. 4 (Amdt. A) while the Preliminary Amendment filed on 22 JUL 02 has been entered as paper no. 10 (Amdt. B). Following the entry of the Preliminary Amendments **Claim(s) 1-94** is/are pending. **Please note:** a substitute specification with claims was filed in this case but it was **not entered** because it was improperly filed. During a telephonic interview with the attorney of record - Jonathan Blanchard - on 13 NOV 02 the examiner was informed that the substitute specification had been filed in error and that it should be disregarded. Accordingly, the substitute specification has been marked **Do Not Enter** but remains in the file wrapper.

### 35 USC § 112- 2ND PARAGRAPH

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

3. **Claim(s) 6, 12, 22, 30, 37-38, 49, 61, 73, 81 and 88-89** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim(s) 6, 12, 22, 30, 38, 49, 61, 73, 81, 88** is/are indefinite because they recite an improper Markush group. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

**Claim(s) 37 and 88** is/are indefinite because the phrase "the reactive site" lacks proper antecedent basis in Claim 1 and 44, respectively.

#### NONSTATUTORY DOUBLE PATENTING

**4.** The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**5.** **Claim(s) 1-43** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of Johnson et al. [US Patent 6,372,813 (16 APR 2002)] in view of Schena et al. (1998). Although the conflicting claims are not identical, they are not patentably distinct from each other.

**6.** **Claim(s) 44-94** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of Johnson et al. [US Patent 6,372,813 (16 APR 2002)] in view of Wang et al. (1995). Although the conflicting claims are not identical, they are not patentably distinct from each other.

#### PRIOR ART

**7.** The claimed invention appears to be free of the prior art because the applicant is the first to describe a method of performing expression analysis and/or SNP detection wherein the microarray is formed by attaching the probe(s) to a polymer coated support via 2+2 photocycloaddition. The only piece of "prior art" that concerns me is the patent issued to Motorola and which describes the preparation a polymer coated support (i.e. microarray) via 2+2 photocycloaddition. It is noted that US Patent 6,372,813 has a different inventive entity with one inventor in common with the instant application, and that the


instant application claims priority to 09/344,620 now US Patent 6,372,813. Finally, during a telephonic interview with the attorney of record - Jonathan Blanchard - on 13 NOV 02 the examiner was informed that the instant invention had been sold to Amersham. Please clarify.

**CONCLUSION**

**8.** Claim(s) 1-94 is/are rejected and/or objected to for the reason(s) set forth above.

**9.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.

  
**ETHAN C. WHISENANT**  
**PRIMARY EXAMINER**